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10/512,078	11/05/2004	Fabio Franceschi	023349-00298	3042
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AREN'T FOX LLP			EXAMINER	
1050 CONNECTICUT AVENUE, N.W.			THAKUR, VIREN A	
SUITE 400				
WASHINGTON, DC 20036			ART UNIT	PAPER NUMBER
			1794	
			NOTIFICATION DATE	DELIVERY MODE
			11/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/512,078	<b>Applicant(s)</b> FRANCESCHI, FABIO
	<b>Examiner</b> VIREN THAKUR	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 January 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 and 7-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 and 7-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Objections***

1. Claims 14-16 are objected to as being dependent on cancelled claims 5 and 6.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 2, 3, 7 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Favre (CH 688686).**

Regarding claim 1, Favre discloses a capsule (figure 2a) used to prepare an infused beverage such as coffee/espresso (see 2nd paragraph of the translation), comprising a first container (figure 2a, item 71) containing a substance to be extracted or dissolved separate from the product contained in the main compartment (7). The product in the main compartment is to be dissolved. It is noted that Favre discloses wherein the first container (71) comprises a side made from a membrane comprising holes (see column 3, lines 31-39) which are further comprised of a mixture of fibers (see column 3, line 63 to column 4, line 18). Favre further discloses a second container (figure 2a item 1) attached to the first container. Regarding the limitation of the first container made of a "substantially flexible material, it is noted that since the filter (42)

which comprises the pod is made of a filter material, that it inherently is considered "substantially flexible." The second container is a cartridge and is made from either aluminum or plastic (column 2, lines 12-19 and column 4, lines 26-31) and therefore is considered "substantially rigid." It is noted that in both cases, the terms "substantially rigid" and "substantially flexible" do not provide specificity as to what would be considered rigid and what would be considered flexible, since the specification does not define these phrases either. Favre further discloses a top of the capsule covered by a removable sheet of protective material (figure 2a, item 41).

Regarding claim 2, it is noted that the first container is defined by items 41 and 42. Favre thus discloses wherein item 42 is heat sealed to the top of the cartridge (50) (see column 3, lines 31-39).

Regarding claim 3, by heat sealing, Favre is in essence gluing the first container to the second container, since as a result of heat sealing the melted material acts like a glue to thus create the seal.

Regarding claims 7 and 15-16, Favre discloses wherein the cartridge can be made from plastic, as discussed above. Since the cartridge assembly has been made to prepare coffee, for instance, the plastic used would inherently have been a food safe plastic material.

Regarding claim 14, Favre discloses wherein the first container is a pod made of a filter material, as discussed above.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Favre (CH 688686) in view of Brody (The Encyclopedia of Food Packaging Technology).**

Regarding claim 4, Favre teaches heat sealing and thus gluing the first container to the second container. Claim 4 differs in specifically reciting another method for securing the first container to the second container. It is noted that in the case of claim 4 and even claims 2-3, the particular recited method by which the first container was fixed to the second container has been a conventional method for adhering one item to another. Specifically with respect to ultrasound sealing, it is noted that Brody teaches that it has been conventional in the art to use ultrasonic sealing for its art recognized

and applicants' intended purpose. To therefore substitute one conventional sealing method for another conventional sealing method would have been an obvious matter of choice and/or design for the purpose of achieving the desired sealing properties between the two containers.

**7. Claims 7-10 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Favre (CH 688686) in view of Arkins et al. (US 6116782), Lagneaux (EP 0007876) and Cai (US 20020078831) and as further evidenced by Robichaud et al. (US 5782404).**

Claims 7 and 15-16 recite wherein the rigid container comprises a cartridge made of a food safe plastic material. It is noted, as discussed above, that Favre teaches wherein the cartridge can be made from plastic. Although not specifically reciting that the plastic is food safe, since the cartridge is used to hold food products, it would have been obvious to one having ordinary skill in the art to make the cartridge out of a food safe material, for the purpose of ensuring that the packaging does not contaminate the food.

Regarding claim 8, Favre discloses wherein the bottom surface of the cartridge is pierced, as shown in figure 6. Therefore, Favre teaches that it has been conventional in the art to pierce a portion of the cartridge for the purpose of releasing the beverage.

The claim differs from Favre in specifically reciting wherein the bottom surface of the cartridge has a hole in it, covered by a seal which is designed to be pierced or removed.

Arkins et al. teaches that it was conventional in the art to apply an area of weakness over a hole, for facilitating piercing of the container and providing access to the contents within the container (see abstract). Lagneaux teaches openings in the bottom of the cartridge (figure 1, item 20), which are sealed (figure 1, item 16) and that are also pierced. Cai also teaches providing an area of weakness over a hole within the cartridge, which is broken and thus releases the liquid contained therein (paragraph 0045 and 0049). Robichaud et al. has been relied on to teach that it was conventional in the art to employ a frangible material over a hole for the purpose of facilitating breaking of the material in order to release the contents therein (See figure 4). To therefore modify Favre and employ a hole which is then sealed with a frangible material would therefore have been obvious for its art recognized and applicant's intended function of facilitating piercing of the container. For instance, the frangible seal, in covering the hole, also maintains the contents sealed within the container.

Regarding claim 9, it is noted that Cai already teaches wherein the seal constitutes a portion of the bottom surface of the cartridge, so that the seal breaks away and releases the contents within the cartridge (Paragraph 0049 and figure 7a, for instance). Since Favre already pierce the bottom of the cartridge, to modify Favre and use a seal which constitutes a bottom surface of the cartridge, for the purpose of

facilitating piercing of the cartridge, would have been obvious in view of the art taken as a whole.

**8. Claims 10-13 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 7-10 and 15-16 above, and in further view of Cai (US 6777007) and Harriss (US 2965501), Bernhardt (US 4340138) and Petrofsky et al. (US 5045333).**

Regarding claim 10, Favre teaches a rigid second container made of a food safe plastic material, as discussed above, and a first container comprising a pod made of a filter material, as discussed above. The references to Arkins et al. and Cai '831 have been relied on to teach a seal constituting the bottom surface of the cartridge.

The claim differs in specifically reciting wherein the pod is filter paper. It is noted that Favre already teaches wherein the pod is made of a sheet of non-woven fibers. Although this does not specifically teach filter paper, it is noted that paper is also made from cellulose fibers. In any case Cai '007 teaches that it was conventional to employ a "pod" which comprises an extractable material, wherein the "pod" is made from filter paper (column 9, line 42 to column 10, line 10). To therefore modify the combination and specifically use filter paper would have been an obvious substitution of one conventional material for filtering the liquid for another conventional material for filtering the liquid.

Regarding the annular outer ridge fixed to an annular protuberance on the plastic cartridge, it is noted that Favre teaches this structure, as seen in figure 2a. In this case,

the bottom portion of the pod (42) is secured to a matching protuberance. In any case, Harriss (Figure 3), Bernhardt (Figures 1 and 3) and Petrofsky et al. (Figure 2), all teach that it was a conventional expedient in the art to mate an annular edge with an annular protuberance for the purpose of securing a first smaller container into a second larger container. To therefore modify the combination, if even necessary, and employ a conventional mating structure, as taught by the art taken as a whole, would have been obvious to one having ordinary skill in the art for the purpose of securing a first container within a second container.

Regarding claim 11, Favre disclose wherein the protective cover material is removably placed over the top of the filter paper pod and mates with the annular protuberances of the cartridge, as shown in figure 2b.

Regarding claim 12, it is noted that Favre teaches making coffee and espresso drinks and wherein the substance in the first container is an extractable substance, while the substance in the second container is a soluble substance. The claim differs from Favre in specifically reciting wherein the material in the first container comprises powdered coffee.

It is noted, as evidenced by Cai '007 in figure 11, for instance, item 33 is powdered milk and item 33a is ground (or powdered) coffee (also see column 9, line 61 to column 10, line 10). By putting the coffee grounds on top of the powdered milk, Cai '007 teaches preventing clogging of the filter paper (column 10, lines 6-10). To therefore modify the combination and employ coffee grounds in the first compartment

and powdered milk in the second would have been obvious for the purpose of preventing clogging of the filter.

Claims 17-20 are rejected for the reasons given above with respect to claim 10.

Claims 21 and 23 are rejected for the reasons given above with respect to claims 10 and 11. The limitations of claim 22 are taught by the combination as discussed above with respect to claim 10. Regarding the limitation of the seal of suitable material designed to be pierced when the capsule as to be used and to re-close the hole when the capsule as already been used, it is noted that Favre teaches in figure 6, wherein the piercing leaves a portion of the pierced material connected to the container (figure 6, item 26) and therefore the material of the covering seal is of a suitable material to re-close the hole when the capsule has already been used. Additionally, the foil taught by the combination would also have been a suitable material for reclosing the hole.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-21 and the teachings of the Goros and Nelsen references have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4553693 and US 5348217 disclose seals over openings which when pierced access the contents within the container. US 5243164 discloses seals over apertures in cartridges which are then broken to release the contents.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIREN THAKUR whose telephone number is (571)272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steve Weinstein/  
Primary Examiner, Art Unit 1794

/V. T./  
Examiner, Art Unit 1794

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